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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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OGILVY RENAULT LLP 1981 MCGILL COLLEGE AVENUE SUITE 1600 MONTREAL, QC H3A2Y3 CANADA			EXAMINER EASWARAN, DAVID S	
			ART UNIT	PAPER NUMBER
			4114	
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			01/06/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/532,820

Applicant(s)

JODOIN, PIERRE-PAUL

Examiner

DAVID S. EASWARAN

Art Unit

4114

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-13 is/are rejected.
7) ☒ Claim(s) 1 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 26 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the application filed on 04/26/2005.
2. Claims 1 – 13 are currently pending and have been examined.

Claim Objections

3. Claim 1 objected to because of the following informalities: limitation ix uses the word *recordal* instead of "recording." Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim states, in part, *identifying used vehicles from new vehicles and imputing any physical damage of said used vehicle into said databank*. It is unclear, however, the intended meaning of "identifying used vehicles from new vehicles" really means. The examiner will assume that this limitations means the invention merely distinguishes when a vehicle is a used vehicle, and will then enter damage information into the database only for used vehicles.

Regardless of the correctness of the interpretation, applicant is required to amend the limitation to make clear its intended meaning.

Further, the claim states "IATA codes." The use of acronyms is unclear. Applicant is required to spell out the acronym.

6. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the claim states that *the intensive marking alphanumerical code uses an international coding system for identifying the region of origin of the owner*. However, there are multiple plausible interpretations of the term "international coding system." For example, it could mean a coding system that can be used in multiple nations or it could mean a coding system that is officially recognized in multiple nations. For the purposes of this examination, the examiner will interpret the term to mean a coding system that can be used in more than one nation.
7. Claims 2 and 4-13 are rejected for depending on indefinite claims.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

As to claims 1-13, the steps recited do not qualify as a statutory process. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

The claims are not tied to another statutory class, nor do they transform any underlying subject matter. Therefore, the claims are non-statutory.

Art Rejections

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

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skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 1 – 4 and 9 – 11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose, Jr. (US 5,521,815, hereinafter Rose) in view of Hall and McGuff (US 6,076,859, hereinafter Hall).

Claim 1:

Rose discloses the following:

- *establishing a service network including a service center having a databank for data processing and storage, and at least one service station providing anti-theft marking service to clients* (See at least Rose column 5, lines 14 – 19);
- *iii) sending the collected information from the service station to the databank of the service center through a computer link* (See at least Rose column 5, lines 36 – 38);
- *iv) at the service center, processing and storing the received information* (See at least Rose column 5, lines 41 – 50, showing the database taking the information, processing it to create assign new title and registration information, and storing the data.);
- *vi) issuing a temporary certificate corresponding with the vehicle, to the client and an insurance company* (See at least Rose column 16, lines 21 – 25, showing

certificate creation and distribution to the client. Further, see Rose column 16, lines 4 – 13, showing a receipt corresponding to the vehicle being sent to an insurer);

- *vii) identifying used vehicles from new vehicles and imputing any physical damage of said used vehicle into said databank* (See at least Rose column 16, lines 35 - 50, showing that for salvage vehicles, information regarding the state of the vehicle is input into the database.);
- *viii) storing for further reference said temporary certificate with said service network* (See at least Rose column 16, lines 16 – 17, stating that “[t]he information may be stored at the external data bases.”);
- *x) issuing an official certificate to said clients by said service network* (See at least Rose column 16, lines 21 – 25).

Rose does not specifically disclose the following:

- *ii) effecting permanent markings of an alphanumerical code at said service station, and verifying and collecting information on said markings, said markings being effected on a plurality of parts of a vehicle, said marking containing identification information of a client owning the vehicle and wherein said alphanumerical code used the IATA codes to identify a country of origin of said vehicle which allows cross-referencing with the vehicle identification number thereof, and at least one part of the vehicle having a visible logo identifying the anti-theft service;*
- *v) linking the databank of the service network to the at least one service station, the insurance company, a police department and the national customs department, characterized in that there is further provided the steps of:*
- *ix) processing collected information associated with said alphanumerical codes and transmitting same to said police department and customs department for verification and recordal; and*

Hall, however, does disclose these limitations.

Regarding limitation "ii" above, Hall discloses effecting permanent markings of an alphanumeric code at the service station and on a plurality of parts (See at least Hall, column 7, lines 31 – 35, showing the unique alphanumeric code. Further see Hall, column 7, lines 55 – 62, showing the codes being placed on numerous parts of the car.). Additionally, although Hall does not specifically use IATA codes to identify a region of origin, Hall does contemplate tracking the regions where parts are labeled (See at least Hall, column 8, lines 50 – 53, stating that "[a]dvantages to such a system include both tracking inventory and increasing the likelihood that equipment designated for use in particular areas or regions will not be removed therefrom."). It would have been obvious for one of ordinary skill in the art at the time of the invention to use region-specific identifying information such as IATA codes with the barcode functionality of Hall, because such a combination would further "[increase] the likelihood that equipment designated for use in particular areas or regions will not be removed therefrom." (See Hall, column 8, lines 51 – 53).

Regarding limitation "v" above, Rose discloses linking the service stations and the service network (See at least Rose column 5, lines 13 – 16), but does not disclose a connection to a local or national law enforcement body. Hall does disclose such a connection (See at least Hall column 8, lines 9 – 14).

Regarding limitation "ix" above, Hall further discloses transmitting the processed information to the local and national authorities (See at least Hall column 9, lines 13 – 16).

It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the anti-theft registration database of Rose with the car-part labeling system of Hall to "provide a method for marking personal property, and more particularly a method for marking personal property having a multiplicity of individually-valuable

component parts, for inventory-tracking and anti-theft purposes" (Hall, column 3, lines 6 – 10).

Claim 2:

The rejection of claim 1 above is incorporated herein. Rose does not specifically disclose *the intensive marking alphanumeric code identifies a region of origin of an owner of the vehicle.*

However, Hall contemplates the importance of regional identification (See at least Hall, column 8, lines 33 – 37, stating that "[t]he present invention not only provides a substantial deterrent to theft and an excellent means of identifying stolen property, but also provides an excellent label system for tracking the location of movable goods in inventory."). It would have been obvious for one of ordinary skill in the art at the time of the invention to specifically include region information within each identification number in a Rose-Hall combination because it would result in "increasing the likelihood that equipment designated for use in particular areas or regions will not be removed therefrom" (Hall, column 8, lines 51 – 53).

Claim 3:

The rejection of claim 2 above is incorporated herein. Rose does not specifically disclose *the intensive marking alphanumeric code uses an international coding system for identifying the region of origin of the owner.*

However this new limitation is nonfunctional descriptive material. The steps would be performed the same regardless of the data. Specifically, it is unclear how any method captured by claim 2 is not also captured by claim 3, since any coding system is capable of use in multiple nations and is therefore an international coding system. Thus, this descriptive material will not distinguish the claimed invention from the prior art in

terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to use an international coding system, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Claim 4:

The rejection of claim 2 above is incorporated herein. Rose does not specifically disclose that *the intensive marking alphanumerical code is engraved on surfaces of the parts of the vehicle*.

Hall, however, does disclose engraving the code onto surface of the parts of the vehicle (See at least Hall, column 1, line 61 to column 2, line 41, discussing two forms of engraving codes onto surfaces of vehicles.)

It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the engraving techniques described in Hall with the Rose-Hall combination described above because such a combination would be "focused on theft prevention and recovery of stolen merchandise" (Hall, column 2, lines 52 – 53).

Claim 9:

The rejection of claim 1 above is incorporated herein. Rose further discloses *sending a request for a temporary certificate from the service station to the service center when the vehicle already has the intensive marking alphanumerical code and the logo thereon* (See at least Rose column 11, lines 21 – 35, showing the re-registration process, which must be done annually in many states. Inherently, this re-registration process will only be performed after the vehicle has already been marked by the system.).

Claim 10:

The rejection of claim 9 above is incorporated herein. Rose further discloses *verifying the intensive marking alphanumerical code and logo on the individual motor parts and external parts of the vehicle upon the receipt of the temporary certificate from the service center* (See at least Rose column 11, lines 32 – 34).

Claim 11:

The rejection of claim 10 above is incorporated herein. Rose does not specifically disclose *adding the intensive marking alphanumerical code to a number of selected unmarked parts of the vehicle*.

Hall does disclose adding the markings to previous unmarked parts, however (See at least Hall column 7, lines 55 – 62.).

It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the anti-theft method with the car-part labeling system of Hall to “provide a method for marking personal property, and more particularly a method for marking personal property having a multiplicity of individually-valuable component parts, for inventory-tracking and anti-theft purposes” (Hall, column 3, lines 6 – 10).

Claim 13:

The rejection of claim 4 above is incorporated herein. Rose does not specifically disclose *obtaining signatures of the client and an agent of the service station on the certificate upon the completion of the verification and collection of the information and the inspection of the existing damages of the vehicle*.

However, Rose does disclose verification and collection of the information regarding damages to a vehicle and further contemplates adding security to the process by employing multiple parties, including the client, the title insurance company and the DMV (See at least Rose column 10, lines 59 – 67). It is likely that such a process would

involve the signatures of the parties as an essential step, despite the reference not specifically mentioning such an element.

Regardless, it would have been obvious for one of ordinary skill in the art at the time of the invention to add the additional security measure of requiring the signatures of the parties to the inspection and verification process to be entered on the certificate, because it would add an additional check against potential fraud on the part of any party, and provide more reliability to the method as a whole.

12. Claims 5 – 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose in view of Hall and further in view of Dumford, *Identification systems deter car thieves*; [Final Edition], The Gazette, Montreal, Quebec (Sept. 30, 1989), hereinafter Dumford.

Claim 5:

The rejection of claim 1 above is incorporated herein. The Rose-Hall combination does not specifically disclose *installing the markings, including the intensive marking alphanumerical code and the visible logo, on the vehicle at the service station when the vehicle does not have the markings.*

However, Dumford does disclose that installation of the markings has been done at service stations (See at least Dumford, stating that “[a]t least two other comprehensive anti-theft marking systems are sold through Montreal car dealers.”) and that visible logos are standard fare for these services (See at least Dumford, stating that “[s]ome experts suggested that logos are in themselves a deterrent (One logo, from Secure-A-Car, glows in the dark.).”).

It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the Rose-Hall combination with the installation specifics disclosed in Dumford because you can't "expect the markings produced by an inexpensive do-it-

yourself kit to match the effectiveness of professional engraving" and "[t]hieves are likely to bypass a car that sports any anti-theft logo" (Dumford).

Claim 6:

The rejection of claim 5 above is incorporated herein. Rose further discloses *A method as claimed in claim 5 further comprising a step of communicating with the service center to ensure that the intensive marking alphanumerical code provided to the vehicle does not match any existing intensive marking alphanumerical code stored in the databank* (See at least Rose column 8, lines 48 – 62).

Claim 7:

The rejection of claim 7 above is incorporated herein. Dumford further discloses *A method as claimed in claim 5 further comprising steps of installing the markings-on motor parts and installing the markings on external parts of the vehicle* (See at least Dumford, stating that "[t]he Sherlock Antitheft Marking...uses a sandblasting technique to engrave 50 parts of a car. Not just windows, but wheels, transmission and major engine parts.").

It would have been obvious for one of ordinary skill in the art at the time of the invention to mark valuable car parts with the Rose-Hall combination because after such marking, these "components that are sold through car-theft rings – are indelibly identified" (Dumford). With such granular identification, the parts of marked cars could not be as easily resold, and therefore theft of marked cars would be reduced.

Claim 8:

The rejection of claim 7 above is incorporated herein. Dumford further discloses *not less than 50 parts of the vehicle are provided with the markings* (See at least Dumford, stating that "In addition to identifying about 50 parts, the comprehensive systems include computerized records.").

It would have been obvious for one of ordinary skill in the art at the time of the invention to mark at least 50 parts with the Rose-Hall combination because "comprehensive systems that mark a large number of parts...work best" (Dumford).

Claim 12:

The rejection of claim 10 above is incorporated herein. The Rose-Hall combination does not specifically disclose *adding the logo to a number of selected un-marked parts of the vehicle*.

Dumford does disclose using logos in addition to just markings (See at least Dumford, stating that "[t]hieves are likely to bypass a car that sports any anti-theft logo"). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to use logos with the anti-theft marking system because "experts suggested that logos are in themselves a deterrent" (Dumford).

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **David Easwaran** whose telephone number is **571-270-5480**. The Examiner can normally be reached on Monday-Friday, 7:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **JAMES A. REAGAN** can be reached at **571.272.6710**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

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/DAVID S EASWARAN/

1/6/2009

Examiner, Art Unit 4114

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